

REMARKS

The Official Action mailed February 3, 2009 has been carefully considered. Reconsideration and allowance of the subject application, as amended, are respectfully requested.

Response to Amendment

On pages 2-3 of the present Office Action, the Examiner states that the non-elected claims need to be cancelled. While Applicant disagrees, Applicant has nevertheless cancelled the non-elected claims as suggested by the Examiner. Applicant expressly reserves the right to file one or more continuation and/or divisional applications directed to these claims. Nothing in this response should be considered an abandonment and/or dedication of this subject matter.

Claim Rejection – 35 U.S.C. § 102

Claims 69-73 were rejected under 35 U.S.C. § 102(b) as being anticipated by Chan (U.S Patent No. 6,193,724, hereinafter “Chan”). Applicant respectfully disagrees and requests reconsideration and withdrawal in view of the following remarks.

Independent claim 69 recites a method of mapping a surface contour of an articular surface comprising, *inter alia*,

establishing a working axis extending from said articular surface;
providing a first probe having a first diameter;
providing a second probe having a second diameter

The present Office Action advances the view that element 300 (i.e., outrigger 300) in **FIG. 15** of Chan anticipates the first probe of independent claim 69 and that element 300 (i.e., outrigger 300) in **FIG. 18** of Chan anticipates the second probe of independent claim 69.¹ Applicant respectfully disagrees.

¹ See page 2 of the present Office Action.

Chan is understood to be directed to a measuring gauge for measuring the relative position of two bones during surgery.² Applicant respectfully submits that the outrigger 300 in **FIG. 15** of Chan is the same outrigger 300 as illustrated in **FIG. 18**.

For example, Chan discloses making a mark on the greater trochanter with the tip of anchoring pin 105 as generally illustrated in **FIG. 12** (i.e., Step 1). Chan further discloses inserting the anchoring pin 105 into the ilium as generally illustrated in **FIG. 13** (i.e., Step 2). Next, the outrigger 300 is coupled to the locking joint 205 as generally illustrated in **FIG. 14** (i.e., Step 3) and the tip 335 of the outrigger 300 is aligned to the position marked in Step 1 as generally illustrated in **FIG. 15** (i.e., Step 4). The locking joint 205 and the outrigger 300 are then removed from the pin 105 without moving the position of the outrigger 300 relative to the locking joint 205 as generally illustrated in **FIG. 16** (i.e., Step 5). Chan further discloses:

At this point, the surgeon proceeds forward with the total hip replacement surgery in the traditional way, i.e., the hip is dislocated, the upper end of the femur is resected, and trial prostheses are installed in the femur ad the acetabulum.

Once the trial prostheses have been installed in the patient, the hip joint is reduced, **permitting the surgeon to check for proper alignment of the prostheses**, any leg length discrepancy, proper lateral offset, and the stability of the hip joint from dislocation. **This may be quickly and easily accomplished using the present invention, i.e., by re-installing pin sleeve 205, outrigger 300 and locking screw 400 (which are locked together as a single unit) back onto anchoring pin 105 and then noting the position of the outrigger's pointer 335 relative to the mark 615 previously made on the patient's femur (see FIG. 17)**. It should be appreciated that when pin sleeve 205, outrigger 300 and locking screw 400 are re-installed as a locked unit back onto anchoring pin 105, care is taken to ensure that the pin sleeve's distal end 215 engages the anchoring pin's collar 125, whereby measuring gauge 5 will occupy exactly the same position it previously occupied relative to the patient's hip joint.

Accordingly, Applicant respectfully submits that the outrigger 300 in **FIG. 15** of Chan is the same outrigger 300 as illustrated in **FIG. 18** (Applicant notes that **FIG. 18** illustrates a situation where the tip 335 of the outrigger 300 is longitudinally displaced from the mark 615 made on the patient's femur in Step 1).

² See Chan, Abstract.

To this end, Applicant notes that providing a second “probe” having a second diameter as recited in independent claim 69 would change the principle of operation of Chan since the Chan discloses verifying the proper alignment of the prostheses based on marks made using the outrigger 300. Put another way, if a second “probe” having a second diameter were used, then the tip 335 of the second “probe” would not line up with the mark (Step 1) if the prostheses was properly aligned.

In light of the above, Applicant respectfully submits that the rejection of independent claim 69 may be withdrawn upon reconsideration. The remaining claims depend, either directly or indirectly, from independent claim 69. As such, the remaining claims are also believed to be allowable by virtue of their own patentable recitations in addition to their dependency from independent claim 69.

Applicant further notes that the present Office Action advances the view that element 105 (i.e., the anchoring pin) anticipates “establishing a working axis extending from said articular surface” as recited in independent claim 69. Applicant disagrees.

The anchoring pin 105 of Chan is not located on the articular surface being mapped. In contrast, the anchoring pin 105 is secured into the ilium as generally illustrated in **FIG. 13** (i.e., Step 2). Applicant respectfully submits that one of ordinary skill in the art would not understand the *ilium* to be an articular surface. Accordingly, Chan is not understood to teach or suggest “establishing a working axis extending from said articular surface” as recited in independent claim 69.

Applicant further notes that Chan is not understood to teach or suggest mapping a surface contour of an articular surface as generally recited in independent claim 69. As discussed above, Chan is directed to a measuring gauge for measuring the relative position of two bones during surgery.³ The anchoring pin 105 is secured into the ilium and the outrigger 300 is disposed about “the femur’s greater trochanter 610.”⁴ As such, neither the anchor pin 105 nor the outrigger 300 is disposed about an articular surface. Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not understand the measuring gauge 5 of Chan to be configured for

³ See Chan, Abstract.

⁴ See Chan, col. 6, lines 1-2.

“measuring a first distance between at least a first point of said articular surface and a first plane substantially normal to said working axis at a distance substantially equal to said first diameter of said first probe from said working axis” as generally recited in independent claim 69. In contrast to independent claim 69, Chan is only understood to disclose verifying the relative position of two bones.

Turning now to claims 70-73, Applicant notes that the present Office Action fails to address where Chan allegedly anticipates these claims. Applicant notes that the only citation provided in the present Office Action is col. 6, lines 22-30 and lines 64-67. Upon review of these passages, however, Applicant is unable to find any teaching or suggestion for the recitations of claims 70-73. Clarification is therefore respectfully requested.

Having dealt with all the objections raised by the Examiner, it is respectfully submitted that the present application, as amended, is in condition for allowance. Thus, early allowance is earnestly solicited.

If the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fees due, please charge them to our Deposit Account No. 50-2121.

Respectfully submitted,

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